

PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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TECH CENTER 1600/2900

In re Application of:

Phillips *et al.*

Serial No. 09/735,363

Filed: December 12, 2000

For: THERAPEUTICALLY USEFUL  
SYNTHETIC OLIGONUCLEOTIDES

Art Unit: 1635

Examiner: Mary Schmidt

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Assistant Commissioner For Patents  
Washington, D.C. 20231

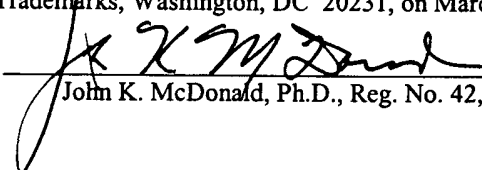
Sir:

Responsive to the Office Action mailed January 4, 2002, a response to which is due March 4, 2002, by virtue of the accompanying petition for a one-month extension and check for \$55.00 for the extension fee, Applicants respectfully request consideration of the appended remarks.

RESTRICTION REQUIREMENT

In response to the Restriction Requirement mailed in the above-identified patent application, Applicants provisionally elect to prosecute the invention

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, DC 20231, on March 4, 2002.

  
John K. McDonald, Ph.D., Reg. No. 42,860

of Group I, Claims 1-10, drawn to nucleic acid compositions, classifiable in class 536, subclass 23.1. This election is made with traverse.

The Restriction Requirement is respectfully traversed. The Examiner states: "Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acids of invention I can be used as probes in assays such as Southern Blots instead of administration to whole organisms for therapeutic purposes as claimed in Invention II." Applicants respectfully traverse this argument. Applicants respectfully submit that the nucleic acids of invention I cannot be used as probes in assays such as Southern Blots. The majority of nucleic acids of invention I are short (no longer than 15 base pairs, see Claims 3, 4, 13, and 14) oligonucleotides and, therefore, will bind to the target DNA non-specifically. For at least this reason, Applicants believe that the Restriction Requirement should be reconsidered and withdrawn. Applicants therefore request that the Examiner reconsider the Restriction Requirement and combine Group I and II for further prosecution in this case.

### SEQUENCE ELECTION REQUIREMENT

In response to the Election Requirement mailed in the above-identified patent application, Applicants provisionally elect SEQ ID NO:45 (GGGAGG). This election is made with traverse.

The Election requirement is respectfully traversed. The Examiner stated that "claims 7 and 8 in Group I and claims 27 and 42 in Group II are drawn to patentable distinct SEQ ID NOS". The Examiner further stated: "Each sequence is patentably distinct because they are unrelated sequences and a further restriction is applied to each Group. For an elected Group drawn to nucleic acid sequences, the Applicant(s) must elect a single nucleic acid sequence (See MPEP 803.04)." The Examiner quoted MPEP 803.04, second paragraph: "Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions with the meaning of 35 U.S.C. §121 and 37 CFR §1.141 et seq."

The Applicants respectfully bring to Examiner's attention that MPEP 803.04, further states:

"Nevertheless, to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 CFR 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application. See *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996).

It has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct will also be examined." (emphasis added)

MPEP 803.04 further states :

"In some exceptional cases, the complex nature of the claimed material, for a example a protein amino acid sequence reciting three dimensional folds, may necessitate that the reasonable number of sequences to be selected be less than ten."

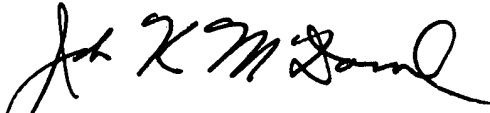
Sequences of Claims 7, 8, 27, and 42 are short non-coding oligonucleotide sequences (less than 30 base pairs) and are not of complex nature. Therefore, the Applicants respectfully request withdrawal of the Election Requirement, and examination of all sequences recited in Claim 7, Claim 8, Claim 27, and Claim 42.

This Response to the Restriction/Election Requirement is fully responsive. Applicants respectfully request that the Examiner contact the undersigned attorney if any questions arise concerning this Response to the Restriction Requirement.

If the Examiner believes any informalities remain in the application that may be corrected by Examiner's amendment, or there are any other issues that can be resolved by telephone interview, a telephone call to the undersigned attorney at (404) 404-745-2470.

No additional fees are believed due, however, the Commissioner is hereby authorized to charge any deficiencies which may be required or credit any overpayment to Deposit Account Number 11-0855.

Respectfully submitted,

  
By: John K. McDonald, Ph.D.  
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Docket No.: 02811-0181 (42368-250224)

## IN THE U.S. PATENT AND TRADEMARK OFFICE

In re Application of:

Phillips *et al.*

Serial No. 09/735,363 ✓

Filed: December 12, 2000

For: Therapeutically Useful Synthetic Oligonucleotides

Docket No. 02811-0181 (42368-250224)

COPY OF PAPERS  
ORIGINALLY FILED

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

Transmitted herewith is a paper in the above-identified application.

- ☒ Response to Restriction/Election Requirement (5 pgs.)  
☒ Petition For One-Month Extension of Time. (1 pg.)  
☒ No additional fee is required.  
☐ The additional fee is calculated as shown below:

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					SMALL ENTITY		OTHER THAN SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDIT. FEE	RATE	ADDIT. FEE
TOTAL	42	MINUS	42=	0	x9	\$0	x18	\$0
INDEP.	6	MINUS	6=	0	x40	\$0	x80	\$0
FIRST PRESENTATION OF								
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIMS					+135	\$	+270	\$
TOTAL						\$0	\$0	
ADDITIONAL FEE						\$0	\$0	

- ☒ A check in the amount of \$55.00 is attached to pay the fee for filing the Petition For One-Month Extension of Time.  
☒ The Commissioner is hereby authorized to charge any additional fees required under 37 CFR §1.16, or credit any overpayment, to Account No. 11-0855. A duplicate copy of this sheet is enclosed.

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Signature

ATLLIB02# 73483.1

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